



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,499	09/01/2000	Michelle A.J. Palmer	4085-226-27	7006

7590

07/25/2003

Steven B Kelber
Piper Marbury Rudnick & Wolfe LLP
1200 Nineteenth Street N W
Washington, DC 20036-2412

EXAMINER

ULM, JOHN D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 07/25/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/654,499

Applicant(s)

Palmer et al.

Examiner

John Ulm

Art Unit

1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 17, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above, claim(s) 19 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-26, 31-37, 41, 42, 46, 50, 51, 55, and 59 is/are rejected.
- 7) ☒ Claim(s) 38-40, 43-45, 47-49, 52-54, and 56-58 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1646

1) Claims 1 to 59 are pending in the instant application. Claims 1, 9, 10 and 18 have been amended and claims 38 to 59 have been added as requested by Applicant in Paper Number 16, filed 24 February of 2003. Claims 38, 43, 47, 52 and 56 have been amended as requested by Applicant in Paper Number 19, filed 17 June of 2003.

2) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 February of 2003 has been entered.

3) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5) Claims 19 and 27 to 30 stand withdrawn from further consideration as being directed to a non-elected invention for those reasons of record in section 5 of Paper Number 13.

6) Claims 1 to 18, 20 to 26, 31 to 37, 41, 42, 46, 50, 51, 55 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Blau et al. patent (6,342,345 B1) in view of the Barak et al. patent (5,891,646) for those reasons of record as applied to claims 1 to 18 and 24 to 30 in section 7 of Paper Number 9 and claims 1 to 18, 20 to 26 and 31 to 37 in section 6 of Paper

Art Unit: 1646

Number 13. Applicant's arguments in traversal of this rejection essentially repeat those arguments of record which were answered section 6 of Paper Number 13.

7) Claims 38 to 40, 43 to 45, 47 to 49, 52 to 54 and 56 to 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Whereas the text in line 49 of column 11 of Blau et al. described the use of a linker to join a binding partner to one of the complementary β -galactosidase mutants described therein, the art of record did not disclose any advantage to employing the specific linker recited in the instant claims in the construction of such a fusion protein.

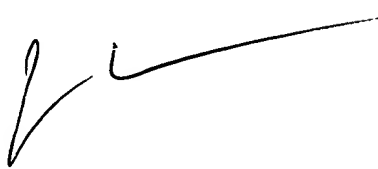
8) Applicant's arguments filed 24 February of 2003 have been fully considered but they are not persuasive for those reasons given above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1600